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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/051,744 | 01/22/2002 | Paul H. Pack | 1047.03 | 1368 |
| 29338 | 7590 | 11/28/2003 | EXAMINER | |
| PARK & SUTTON LLP 3255 WILSHIRE BLVD SUITE 1110 LOS ANGELES, CA 90010 | | | CHANG, CELIA C | |
| | | ART UNIT | | PAPER NUMBER |
| | | 1625 | | S |
| DATE MAILED: 11/28/2003 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------|-------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/051,744 | PAEK, PAUL H. | |
| | Examiner Celia Chang | Art Unit 1625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 April 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
 - 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) Claim(s) 1-4, 6, 7, 9-13, 15 and 16 is/are allowed.
- 6) Claim(s) 5, 8, 14, 17 and 21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) Interview Summary (PTO-413) Paper No(s). _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. Applicant's election without traverse of Group I, claims 1-17, 21 in Paper No. 4, dated April 1, 2003 is acknowledged.

Claims 1-17, 21 are prosecuted. Claims 18-20 are withdrawn from consideration per 37 CFR 1.142(b). Cancellation is recommended.

2. Claims 5, 14 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "...wherein the vinegar is a fermentation from brown rice" is ambiguous and confusing. Please note that fermentation is a process while vinegar is a product. It is unclear what is the claimed scope. Is it a process in a process? Or is it referring to that the vinegar is obtained by the fermentation process. Clarification is required.

3. Claims 8 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 17 recited the limitation "...wherein the composition is one selected from toothpaste, a mouth detergent....." There is insufficient antecedent basis for this limitation in the base claims. Please note that the base claim is a *process* for making an oral composition containing cimicifuga salt or cimicifuga and coptis salts. The processes of the base claims does not result in toothpaste, mouth detergent etc. in absence of additional starting material and steps for preparing such final products. In addition, the specification, while being enabling for making toothpaste, mouth detergent etc. with conventional ordinary oral hygiene compositions well known to one having ordinary skill, does not reasonably provide enablement for the instant claimed scope especially it encompassed all cimicifuga toothpaste, mouth detergent etc. with *additional active* ingredients. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

It is recommended that if the process contains a further step of incorporating of the oral composition comprising cimicifuga produced by the base claims, *the additional step as incorporation of the oral composition with conventional oral hygiene compositions selected from toothpaste, mouth detergent ... etc.* be particularly pointed out in the claims.

4. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 depends on claim 18 which is non-elected. Further, claim 18 is a composition claim wherein claim 21 is a process depending on a composition, thus, it is very confusing as to what is the scope of claim 21. Further, there is insufficient antecedent basis for this limitation in the base claim.

5. Claims 1-4, 6-7, 9-13, 15-16 are allowable. The prior art of record by Dueker et al. Biosis 1992:31936, Liske et al. Biosis 1998 :216584, Burdette et al. Biosis 2003 :26424, Burdette et al. Biosis 2003 :483768, CN119289, CN1221626, JP-09-031094 evidenced that the current process of extracting cimicifuga plants employed alcohols or water with elevated temperature. Zou et al. CA 123 :2060 provided information that low pH and high salts are beneficial in the tissue grinding process to avoid oxidation of phenolic compounds i.e. salts of cimicifuga, no motivation was provided that such low pH and high salts should be conducted in the specific sequential manner as claimed.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 1625

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner can be reached by facsimile at (703) 308-7922 with courtesy voice message supra.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



*Celia Chang
Primary Examiner
Art Unit 1625*

OACS/Chang
Nov. 26, 2003